

REMARKS

Applicant thanks the Examiner for acknowledging the claim for priority under 35 U.S.C. § 119, and receipt of certified copies of the priority documents submitted August 6, 2003.

Applicant notes that the Examiner has not returned an initialed copy of the PTO/SB/08 form submitted with the Information Disclosure Statement filed August 6, 2003. Applicant requests that the Examiner return an initialed copy of this form with the next Action.

Status of the Application

Claims 1-31 are all the claims pending in the Application, as claims 27-31 are hereby added. Claims 1-6, 8-16 and 18-26 stand rejected.

Allowable Subject Matter

Applicant thanks the Examiner for indicating that claims 7, 17 and 22 would be allowed if rewritten in independent form. However, Applicant respectfully requests that the Examiner hold in abeyance such rewriting until the Examiner has had an opportunity to reconsider (and withdraw) the prior art rejection of the other claims.

Indefiniteness Rejection

The Examiner has rejected claims 3, 19 and 23 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The alleged informalities noted by the Examiner have been corrected. Thus, withdrawal of the rejection is respectfully requested.

Prior Art Rejections

The Examiner has rejected: (1) claims 1, 2, 4-6, 8-16 and 18 under 35 U.S.C. § 102(b) as being anticipated by *Tanabe et al.* (US 5,950,808; hereinafter "*Tanabe*"); and (2) claims 19-21

and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over *Kuriyama* (US 6,586,689 B2; hereinafter “*Kuriyama*”) in view of *Tanabe*. These rejections are respectfully traversed.

Independent Claims 1, 2 and 4

The Examiner alleges that *Tanabe*’s diaphragm 35 (FIGS. 12, 13), resin film 36, projection 38 (FIG. 13) and button 39 respectively correspond to the “spring member,” “resin sheet,” “rigid member,” “protrusion part,” recited in independent claims 1, 2 and 4. Further, the Examiner alleges that the “circumferential portion” recited in claims 2 and 4 corresponds to EL element 15, and that it is connected to resin film 36 “via spacer 37 and substrate 32” (O.A., pg. 2).

However, Applicant respectfully submits that *Tanabe* fails to teach or suggest that the substantially rigid member: (1) “is supported by a side of said resin sheet facing the protrusion part” as recited in claim 1; (2) comprises “a circumferential portion adhered to a side of said resin sheet facing the protrusion part” as recited in claim 2; or (3) comprises “a circumferential portion that is secured to a side of said flat portion of said resin sheet facing the protrusion part” as recited in claim 4.

In contrast, the alleged “connection” between projection 14, 38 and resin film 36 can only be interpreted as being provided on a side of resin film 36 facing away from projection 14, 38.

Thus, Applicant respectfully submits that independent claims 1, 2 and 4 are patentable over the applied references. Further, Applicant respectfully submits that rejected dependent claims 5, 6, 8-16 and 18 are allowable, *at least* by virtue of their dependency.

B. Independent Claims 19 and 23-26

As noted above, the Examiner relies upon a combination of *Kuriyama* and *Tanabe* to reject independent claims 19 and 23-26.

More specifically, the Examiner alleges that one of ordinary skill in the art at the time of the invention of the subject matter of the instant Application (“one of skill”) would have been motivated to modify *Kuriyama* “to include a substantially rigid member including protrusion parts and a circumferential part [of *Tanabe*] between the actuator and the resin sheet because this is for the purpose of focusing the force applied on the center of the spring member ensuring proper operation and feel of the switches” (O.A., pgs. 4-5).

Thus, the Examiner seems to be alleging that one of skill would have been motivated to add elements such as the spacer 37, EL element 15 and protrusion 14 of *Tanabe* in the space between keypad 40 and movable contacts 36 in *Kuriyama*. Applicant respectfully disagrees.

First, Applicant respectfully submits that there is no support for the Examiner’s specific reasoning anywhere in either *Kuriyama* or *Tanabe*. As the Examiner concedes, *Kuriyama* is silent regarding the provision of rigid members or protrusion parts, and *Tanabe* does not indicate that the provision of such parts focus the force applied to the spring member. Rather, this reasoning seems only to come from the instant Application. Thus, it appears that the Examiner is attempting to use hindsight reasoning gathered from the instant Application, which is improper.

Second, as discussed above, *Tanabe* is directed to the provision of an EL element 15 on a top surface of a switch, so that undesirable illumination effects caused by intervening elements is prevented (col. 3, lines 20-26). Thus, the entire purpose of *Tanabe* is to avoid having the EL

element 15 covered. Accordingly, one of skill would not have been motivated to provide EL element 15 or the other associated structures of Tanabe *beneath* keytop 40 of *Kuriyama*.

Third, *Kuriyama* is directed to a specific arrangement of keytop 40 with respect to frame 70 so that keytop 40 does not depress multiple switches simultaneously (at least when such depression is not desired). The disclosed arrangement relies on specific gaps and arrangements between the keytop 40, frame 70 and switches 35, 36. The Examiner has not explained (or cited any portion of either reference that shows) how or why one of ordinary skill would have added the features of *Tanabe* to *Kuriyama*'s specific arrangement without destroying the desired functionality of *Kuriyama*.

In view of the above, Applicant respectfully submits that one of skill would not have been motivated to modify *Kuriyama* in view of *Tanabe*, since the mere fact that references can be "combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination [or modification]." *In re Mills*, 916 F.2d 680 (Fed.Cir. 1990); MPEP §2143.01.

Thus, Applicant respectfully submits that independent claims 19 and 23-26 are patentable over the applied references. Further, Applicant respectfully submits that rejected dependent claims 20 and 21 are allowable, *at least* by virtue of their dependency.

Thus, Applicants respectfully request that the Examiner withdraw this rejection.

New Claims

Claims 27-31 are hereby added. Claims 27-31 are fully supported *at least* by FIG. 4A and 4B of the instant Application. Claims 27-31 are respectfully submitted to be allowable both by virtue of their dependency, and by virtue of the features recited therein.

Amendment Under 37 C.F.R. § 1.111
U.S. Appln. No.: 10/634,868

Attorney Docket # Q76270

Conclusion


In view of the foregoing, it is respectfully submitted that claims 1-31 are allowable.

Thus, it is respectfully submitted that the application now is in condition for allowance with all of the claims 1-31.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please charge any fees which may be required to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,



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